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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,335	11/19/2001	Richard L. Pellegrini	106679.01	8588

7590 02/25/2008  
OLIFF & BERRIDGE, PLC  
P.O. Box 19928  
Alexandria, VA 22320

EXAMINER
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BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3772

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02/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/988,335	<b>Applicant(s)</b> PELLEGRINI ET AL.	
	<b>Examiner</b> MICHAEL BROWN	<b>Art Unit</b> 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24,27-40,45,58,59,63-69,73-84,86 and 88-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,27-40,45,58,59,63-69,73-84,86 and 88-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 24, 59, 67-68, 71, 83, 86, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 59, which depends from claim 24, there is a duplicate recitation of "metallic layer does not overlap any portion of the peripheral portion". In claim 67, which depends from claim 24, there is a duplicate recitation of "the plan-view shape is continuous over its entirety". In claim 71, which depends from claim 68, there is a duplicate recitation of the laser resistant layer does not overlap any part of the peripheral portion". In claim 86, which depends from claim 83, there is a duplicate recitation of "metallic layer does not overlap any portion of the peripheral portion".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 30, 34, 40, 45, 58-59, 63-65, 67-69, 71, 76-77, 79-84, 86, 91-92, 94-102 rejected under 35 U.S.C. 102(b) as being anticipated by Laser Aid "Disposable Laser Eye Shield".

Laser Aid "Disposable Laser Eye Shield" discloses a disposable, laser-resistant eye patch comprising a sheet member (the larger foam layer), having an eye-covering portion sized to fit entirely within a human eye socket in at least one dimension of the eye socket, a metallic layer (aluminum) attached to the sheet member, the metallic layer having a plan-view shape, the plan-view shape being continuous over the eyeball covering area, the metallic layer being smaller than the foam layer, (the metallic layer being smaller is being interpreted as not overlapping the peripheral portion of the foam layer), an adhesive layer on at least a portion of the peripheral edge, the foam is a biocompatible foamed plastic material (the foam doesn't cause any harm to the tissue around the eye), the metallic layer is aluminum, a method of protecting a patient's eye during treatment comprising the step of adhering a disposable, laser-resistant eye patch over an eye within the corresponding eye socket of the patient in at least one dimension of the eye socket, the sheet is sized to fit entirely inside the eye socket in both a vertical and lateral dimension of the socket, the peripheral portion extends along the peripheral portion, the treatment is a light procedure, laser surgery or laser procedure, the plan-view shape is continuous over its entirety, the laser resistance layer is a metal foil (aluminum is a foil), the laser-resistance layer doesn't overlap any portion of the peripheral portion (it is smaller than the foam layer) and any layer (the second layer of foam) that doesn't overlap the peripheral edge of the adhesive layer (in order to use the adhesive to attach the patch to the eye, the peripheral edge can't be overlapped). The metallic layer isn't a part of a metallized polymer layer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-29, 31-33, 73-75, 88-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laser Aid "Disposable Laser Eye Shield".

Laser Aid discloses a disposable laser-resistance eye patch, substantially as claimed. However, Laser Aid doesn't disclose what the thickness of the sheet material is or what the thickness of the metallic layer is. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the Laser Aid could be fabricated with the sheet material and the metallic layer having the same thickness recited in the claims because these dimensions aren't critical and they lack an inventive step over the prior art.

Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laser Aid "Disposable Laser Eye Shield" in view of Policastro.

Laser Aid discloses a disposable, laser-resistance eye patch, substantially as claimed. However, Laser Aid doesn't disclose the aluminum being pure or an aluminum alloy. Policastro teaches in figures 1-10 a diffuse reflective laser barrier that can be an eye shield that is made of pure aluminum, an aluminum alloy or a metal alloy (col. 4, lines 16-28). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the pure aluminum or the aluminum alloy as taught by Policastro could be substituted for the aluminum disclosed by Laser Aid

because either type of metal is capable of blocking the light from a laser from the eye of a patient.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laser Aid "Disposable Laser Eye Shield" in view of Policastro, along with Durette.

Laser Aid discloses a disposable, laser-resistance eye patch, substantially as claimed. However, Laser Aid doesn't disclose the metallic layer being a stainless steel, a pure metal or a metal alloy. Policastro teaches in figures 1-10 a diffuse reflective laser barrier that can be an eye shield that is made of pure aluminum, an aluminum alloy or a metal alloy (col. 4, lines 16-28). Durette teaches in figures 1-5 an eye shield comprising a metallic layer that is stainless steel (col. 2, lines 10-13). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the pure aluminum or the aluminum alloy as taught by Policastro or the stainless steel as taught by Durette could be substituted for the aluminum disclosed by Laser Aid because either metal is capable of blocking a laser light from reaching a patient's eye.

Claims 66, 78 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laser Aid "Disposable Laser Eye Shield" in view of Kohn.

Laser Aid discloses a disposable, laser-resistance eye patch, substantially as claimed. However, Laser Aid doesn't disclose the eye patch having a tab. Kohn teaches in figure 9 an eye patch comprising a tab 34. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that tab as

taught by Kohn could be incorporated into the eye patch disclosed by Laser Aid in order to use the tab to grasp and remove the eye patch form around the eye socket.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BROWN whose telephone number is (571)272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Brown/  
Primary Examiner, Art Unit 3772

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